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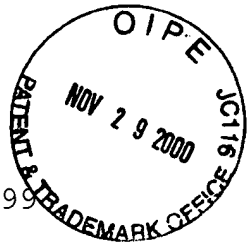
Box Non-Fee Amendment
Attorney Docket No. P-15149

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Y. Bronicki



Serial No.: 09/431,159 Group Art Unit: 1764

Filed: November 1, 1999 Examiner: H. Myers

For: **METHOD OF AND APPARATUS FOR PROCESSING HEAVY HYDROCARBON FEEDS**

RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action dated October 6, 2000. The one month shortened statutory period for response was set to expire on November 6, 2000. A petition for a one-month extension of time and a corresponding check is being submitted herewith in order to extend the period of response to December 6, 2000.

SUMMARY OF RESTRICTION REQUIREMENT

Invention Groups. The Examiner has required restriction of claims 1-10 to a single disclosed species under 35 U.S.C. 121.

As the basis for this restriction requirement, the Official Action states the following:

> Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3, 10, drawn to an apparatus, classified in class 422, subclass 72.
II. Claims 4-9, drawn to a process for processing heavy hydrocarbons, classified in class 208, subclass 309.

The inventions are distinct, each from the other because:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as heating oil sands.

PROVISIONAL ELECTION

Applicants provisionally elect Group I (claims 1-3 and 10) drawn to an apparatus, with traverse. Claims 1-3 and 10 are readable on the elected invention.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement.

First, the restriction requirement is traversed because the Examiner has not met the burden of showing that the apparatus as claimed can be used to practice another and materially different process. The Examiner states that the apparatus can be used for heating oil sands and that heating oil sands would be another and materially different process. However, Applicants respectfully

submit that heating oil sands is not practical in the apparatus of the present inventive subject matter. As such, the present claims are directed to an apparatus for processing hydrocarbon feeds, the apparatus including an atmospheric fractionating tower, a vacuum fractionating tower, a solvent deasphalting unit and a pair of thermal crackers. Applicant respectfully submits that to use the apparatus to heat oil sands would damage these elements of the apparatus, and thus it would not be feasible to use the apparatus to heat oil sands.

Additionally, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required. See MPEP 803. Regardless of any differences which may exist between the inventions set forth in the claims of Groups I and II, a complete and thorough search for the invention set forth in any one of the Groups would require searching the art areas appropriate to the other Groups. All of the Groups are directed to processing a heavy hydrocarbon feed stream. Since a search of each of the inventions of the species would be coextensive, it would not be a serious burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic

search engines providing the Examiner with the ability to quickly and easily search all of the claims. Considering that the Examiner will most likely undertake a search for the apparatus of claim 1, searching for the method of other independent claims would be minimally burdensome on the Examiner.

Moreover, given the overlapping subject matter and classifications of the species, examinations of all the invention groups would not pose a serious burden because they would be coextensive. Further, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Furthermore, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional

applications) are not refundable.

In view of the foregoing, applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement, and to examine all of the claims pending in this application.

If the Examiner has any questions or comments regarding this matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

Respectfully submitted,

NATH & ASSOCIATES

Date: November 29, 2000

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